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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
SALTARELLI, DOMINIC D	

ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/631,583	LIWERANT ET AL.	
	Examiner	Art Unit	
	Dominic D. Saltarelli	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 January 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 19-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 19-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Claims 1-13 and 19-23 are not supported by the Parent application 09/497,587, filed February 3, 2000, nor by the provisional application 60/147,029, filed August 3, 1999, and therefore do not receive the benefit of said dates. Thus, the effective priority date for claims 1-13 and 19-23 is the filing date of the instant application, August 3, 2000.

Election/Restrictions

2. Applicant's election with traverse of species 1 in the reply filed on January 11, 2005 is acknowledged. The traversal is on the grounds that a search of the subject matter of the elected claims should also uncover references relevant to the examination of the subject matter of the non-elected claims. This is not found persuasive because the search conducted did not uncover any such references.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Lines 7-9 of claim 1 read:

(d) accepting from the sender the indication of a selection of the advertisement to be associated with the video segment, the video segment and the advertisement to be sent over the computer network

It is unclear as to the scope of the limitation described above, as the limitation could be interpreted such that: a) the sender provides the indication of selection of the advertisement, the video segment, **and** the advertisement; or b) the selection provided by the sender, the video segment, and the advertisement are accepted. In the interest of advancing prosecution of the instant application, the examiner will consider the scope of the limitation to be the situation described in b) the selection provided by the sender, the video segment, and the advertisement are accepted.

5. Claim 4 recites the limitation "server computer system" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Hjelsvold et al. (6,546,555) [Hjelsvold].

Regarding claim 1, Hjelsvold discloses a method of sending a video segment and an associated advertisement over a computer network (customers select and view video segments sent from a server, col. 2, line 58 – col. 3 line 8, wherein the video segments are streamed to customers with associated advertisements, col. 8, lines 56-65 and col. 12, lines 15-34), comprising:

(a) acquiring a video segment at a computer system (col. 6, lines 61-64);

(b) acquiring advertisements (promotional video inserts) at the computer system (in order to insert said promotional inserts, they must first be acquired by the system, col. 12, lines 15-34);

(c) offering to a sender an opportunity to indicate a selection of an advertisement of the advertisements to be associated with the video segment (the merchant may statically define which promotional video sequences are inserted into the video segments, col. 12, lines 21-34, or the filtering service will select them automatically according to selection parameters, which are set by the merchant, col. 6, lines 14-19);

(d) accepting from the sender the indication of a selection of the advertisement to be associated with the video segment (col. 12, lines 15-34), the segment and the advertisement to be sent over the computer network (the video segment and advertisement are coupled once the advertisement selection has been accepted, col. 8, lines 56-65); and

(e) in response to the indication accepted in step (d), automatically at the computer system:

(i) assuring that the video segment is in a streaming format (col. 8 line 66 – col. 9 line 33);

(ii) creating an identifier for the video segment (an inherent feature, as the computer network in question is the internet, col. 2, lines 58-60, thus the video segment is a file which has identification information associated with it prior to transmission over the internet to the receiving computer);

(iii) associating the video segment and the advertisement (col. 12, lines 15-34); and

(iv) sending the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system (col. 9, lines 34-44).

Regarding claim 2, Hjelsvold discloses the method of claim 1, wherein the step of offering to a sender an opportunity to indicate a selection of an advertisement of the advertisements includes a criterion selectable by the sender (the filtering service uses parameters and selection rules for automatically selecting among available promotional sequences, col. 12, lines 21-34, wherein said parameters are set by the merchant, col. 6, lines 14-19).

Regarding claim 3, Hjelsvold discloses the method of claim 2, wherein the criterion is the length of the advertisement (the filtering parameters include the length of the promotional sequence, as this is a factor considered when selecting promotional sequences for insertion into a video segment, col. 5, lines 14-51, specifically lines 29-33).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hjelsvold.

Regarding claims 4-6, Hjelsvold discloses the method of claims 1 and 2, but fails to disclose the step of offering to a sender an opportunity to indicate a selection of an advertisement includes a randomized default selection if the sender fails to indicate a selection (which equates to affirmatively leaving the selection to the determination of the server computer system).

Examiner takes official notice that it is notoriously well known in the art to rely upon a randomized selection of necessary data in the absence of user input specifying a particular data. In many software driven computer systems, such as the video streaming system disclosed by Hjelsvold, certain data blocks are

necessary for the proper operation of the system, such as the insertion of promotional video inserts into a video requested by a user based upon the version selected by a user (shown in Hjelsvold, col. 5, lines 14-51). If a user does not specify which data is to be selected for the proper operation of the system, said data must be otherwise selected for continued operation, such as in Hjelsvold, if the user does not specify a promotional video or any selection parameters for the selection of a promotional video, there still must be a selection parameter which will insert the promotional videos when they are necessary (when the user selects a version which includes promotional videos). A randomized default selection ensures the proper operation of the system and prevents the same data from being included every time the user does not specify the data to include.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Hjelsvold to include a randomized default selection if the sender fails to indicate a selection, for the benefit of maintaining continuous and proper execution of the system in the even that the user either purposely or inadvertently does not specify advertisement selection criterion, without displaying the same promotional video [advertisement] too often.

10. Claims 7-11, 13, and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hjelsvold in view of Ellis et al. (6,774,926) [Ellis].

Regarding claim 7, Hjelsvold discloses a method of sending a video segment and an associated advertisement over a computer network (customers select and view video segments sent from a server, col. 2, line 58 – col. 3 line 8, wherein the video segments are streamed to customers with associated advertisements, col. 8, lines 56-65 and col. 12, lines 15-34), comprising:

(a) acquiring a video segment at a computer system (col. 6, lines 61-64);

(b) selecting, by the sender, an advertisement stored at the server computer system (the merchant may statically define which promotional video sequences are inserted into the video segments, col. 12, lines 21-34, or the filtering service will select them automatically according to selection parameters, which are set by the merchant, col. 6, lines 14-19); and

(c) prior to sending the video segment and advertisement over the computer network, the server computer system automatically:

(i) assures that the video segment is in a streaming format (col. 8 line 66 – col. 9 line 33);

(ii) creates an identifier for the video segment (an inherent feature, as the computer network in question is the internet, col. 2, lines 58-60, thus the video segment is a file which has identification information associated with it prior to transmission over the internet to the receiving computer);

(iii) associates the video segment and the advertisement (col. 12, lines 15-34); and

(iv) sends the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system (col. 9, lines 34-44).

Hjelsvold fails to disclose uploading a video segment from a sender computer system to the server computer system and transmitting from the sender computer an indication of an intent to send the video segment and the advertisement over the computer network.

In an analogous art, Ellis teaches uploading a video segment from a sender computer system to a server computer system (col. 3 line 55 – col. 4 line 4 and col. 7, lines 38-48), allowing smaller entities, such as home users, to create and provide video content (col. 3, lines 19-29). Additionally, Ellis teaches providing a sender with the ability to transmit an indication of an intent to send the uploaded content (the contributor designates an uploaded video as being available to others "on demand", col. 11 line 65 – col. 12 line 1), for the benefit of allowing a sender to control the availability of content the sender has provided.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Hjelsvold to include uploading a video segment from a sender computer system to the server computer system and transmitting from the sender computer an indication of an intent to send the video segment, as taught by Ellis, for the benefit of allowing smaller entities, such as home users, to create and controllably provide video content, such as personalized, or special interest, content.

Regarding claim 8, Hjelsvold and Ellis disclose the method of claim 7, wherein selecting an advertisement comprises using a criterion chosen by an operator of the sender computer system (Hjelsvold teaches the filtering service uses parameters and selection rules for automatically selecting among available promotional sequences, col. 12, lines 21-34, wherein said parameters are set by the merchant, col. 6, lines 14-19).

Regarding claim 9, Hjelsvold and Ellis disclose the method of claim 8, wherein the criterion is the length of the advertisement (Hjelsvold teaches the filtering parameters include the length of the promotional sequence, as this is a factor considered when selecting promotional sequences for insertion into a video segment, col. 5, lines 14-51, specifically lines 29-33).

Regarding claims 10 and 11, Hjelsvold and Ellis disclose the method of claim 8, but fail to disclose said criterion includes leaving said selection to the determination of said server computer system which selects the advertisement in a substantially randomized manner.

Examiner takes official notice that it is notoriously well known in the art to rely upon a randomized selection of necessary data in the absence of user input specifying a particular data. In many software driven computer systems, such as the video streaming system disclosed by Hjelsvold, certain data blocks are

necessary for the proper operation of the system, such as the insertion of promotional video inserts into a video requested by a user based upon the version selected by a user (shown in Hjelsvold, col. 5, lines 14-51). If a user does not specify which data is to be selected for the proper operation of the system, said data must be otherwise selected for continued operation, such as in Hjelsvold, if the user does not specify a promotional video or any selection parameters for the selection of a promotional video, there still must be a selection parameter which will insert the promotional videos when they are necessary (when the user selects a version which includes promotional videos). A randomized default selection ensures the proper operation of the system and prevents the same data from being included every time the user does not specify the data to include.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Hjelsvold and Ellis to include a randomized default selection if the sender leaves selection to the determination of said server computer system, for the benefit of maintaining continuous and proper execution of the system in the even that the user either purposely or inadvertently does not specify advertisement selection criterion, without displaying the same promotional video [advertisement] too often.

Regarding claim 13, Hjelsvold discloses a system for sending a video and an associated advertisement over a computer network (customers select and

view video segments sent from a server, col. 2, line 58 – col. 3 line 8, wherein the video segments are streamed to customers with associated advertisements, col. 8, lines 56-65 and col. 12, lines 15-34), comprising:

(b) a second computer system comprising storage and for connection to other computer systems over a computer network (filtering server 10 in fig. 1), the second computer system including:

(7) a seventh module operating on the second computer system for storing an advertisement (promotional video sequences are stored in order to be retrieved for insertion into a video, col. 12, lines 15-21);

(8) and eighth module operating on the second computer system for associating the advertisement with the video segment (col. 12, lines 22-34);

(9) a ninth module operating on the second computer system for storing the video segment and an associated identifier in the storage (digital video repository, col. 7, lines 11-27, wherein all digital files inherently have associated identifiers, which allows the files to be retrieved from storage);

(10) a tenth module operating of the second computer system for receiving an indication to associate the stored video segment and the advertisement (col. 12, lines 22-34);

(11) an eleventh module operating on the second computer system for automatically assuring that the video segment is in a streaming video format (col. 9, lines 7-33); and.

(12) a twelfth module operating on the second computer system for sending the video segment, the identifier, and the associated advertisement from the storage to a receiver computer system (col. 9, lines 34-44).

Hjelsvold fails to disclose:

(a) a first computer system for connection to other computer systems over a computer network, the first computer system including:

(1) a first module operating on the first computer system for acquiring a video segment;

(2) a second module operating on the first computer system for generating an identifier associated with the video segment;

(3) a third module operating on the first computer system for accepting an indication of intent to send the video segment to another computer;

(4) a fourth module operating on the first computer system for automatically sending the video segment and the identifier over the computer network to a receiving computer;

(5) a fifth module operating on the first computer system for accepting from a sender an indication of an advertisement to be

associated with the video segment and for transmitting the indication to another computer; and

(b) on the second computer system:

(6) a sixth module operating on the second computer system for automatically receiving the video segment.

In an analogous art, Ellis discloses a system for uploading videos from a sender to a server (col. 3, lines 19-29 and col. 7, lines 39-48), including:

(a) a first computer system for connection to other computer systems over a computer network (col. 5, lines 61-67), the first computer system including:

(1) a first module operating on the first computer system for acquiring a video segment (col. 3, lines 19-29 and col. 6, lines 1-23);

(2) a second module operating on the first computer system for generating an identifier associated with the video segment (an inherent feature of digital files, said identifier would identify the name or location of the file, or include information regarding the format of the file, see col. 4, lines 6-18);

(3) a third module operating on the first computer system for accepting an indication of intent to send the video segment to another computer (the user at the first computer system actively uploads the video to a server, col. 7, lines 39-48, which requires accepting an indication of intent to send the segment to the server from the user);

(4) a fourth module operating on the first computer system for automatically sending the video segment and the identifier over the computer network to a receiving computer (col. 7, lines 39-48); and

(b) on the second computer system (the server):

(6) a sixth module operating on the second computer system for automatically receiving the video segment (col. 7, lines 39-48).

This provides the benefit of allowing smaller entities, such as home users, to create and provide video content as a merchant of video content (col. 3, lines 19-29).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Hjelsvold to include:

(a) a first computer system for connection to other computer systems over a computer network, the first computer system including:

(1) a first module operating on the first computer system for acquiring a video segment;

(2) a second module operating on the first computer system for generating an identifier associated with the video segment;

(3) a third module operating on the first computer system for accepting an indication of intent to send the video segment to another computer;

(4) a fourth module operating on the first computer system for automatically sending the video segment and the identifier over the computer network to a receiving computer;

(5) a fifth module operating on the first computer system for accepting from a sender an indication of an advertisement to be associated with the video segment and for transmitting the indication to another computer (wherein the fifth module is result of the combination of Hjelsvold and Ellis, as the first computer system acts as the merchant who performs said advertisement selection described in col. 12, lines 15-34 in Hjelsvold, which requires the first computer system accept said input from the user); and

(b) on the second computer system:

(6) a sixth module operating on the second computer system for automatically receiving the video segment, as taught by Ellis, for the benefit of allowing smaller entities, such as home users, to create and controllably provide video content, such as personalized, or special interest, content.

Regarding claim 19, Hjelsvold and Ellis disclose the system of claim 13, wherein the second computer system includes a module for obtaining from a user of said first computer an indication of which advertisement is to be inserted with the video sent by the first computer (result of the combination of Hjelsvold and Ellis, as the first computer system acts as the merchant who performs said

advertisement selection described in col. 12, lines 15-34 in Hjelsvold, which requires the second computer system accept said input from the first computer system).

Regarding claim 20, Hjelsvold and Ellis disclose the system of claim 19, wherein said module for obtaining an indication of which advertisement is to be associated with the video uses a criterion for said association (Hjelsvold teaches the filtering service uses parameters and selection rules for automatically selecting among available promotional sequences, col. 12, lines 21-34, wherein said parameters are set by the merchant, col. 6, lines 14-19).

Regarding claim 21, Hjelsvold and Ellis disclose the method of claim 20, wherein the criterion is the length of the advertisement (Hjelsvold teaches the filtering parameters include the length of the promotional sequence, as this is a factor considered when selecting promotional sequences for insertion into a video segment, col. 5, lines 14-51, specifically lines 29-33).

Regarding claims 22 and 23, Hjelsvold and Ellis disclose the system of claim 19, but fail to disclose said criterion includes leaving said selection to the determination of said server computer system which selects the advertisement in a substantially randomized manner.

Examiner takes official notice that it is notoriously well known in the art to rely upon a randomized selection of necessary data in the absence of user input specifying a particular data. In many software driven computer systems, such as the video streaming system disclosed by Hjelsvold, certain data blocks are necessary for the proper operation of the system, such as the insertion of promotional video inserts into a video requested by a user based upon the version selected by a user (shown in Hjelsvold, col. 5, lines 14-51). If a user does not specify which data is to be selected for the proper operation of the system, said data must be otherwise selected for continued operation, such as in Hjelsvold, if the user does not specify a promotional video or any selection parameters for the selection of a promotional video, there still must be a selection parameter which will insert the promotional videos when they are necessary (when the user selects a version which includes promotional videos). A randomized default selection ensures the proper operation of the system and prevents the same data from being included every time the user does not specify the data to include.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Hjelsvold and Ellis to include a randomized default selection if the sender leaves selection to the determination of said server computer system, for the benefit of maintaining continuous and proper execution of the system in the even that the user either purposely or inadvertently does not

specify advertisement selection criterion, without displaying the same promotional video [advertisement] too often.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hjelsvold and Ellis as applied to claim 10 above, and further in view of Eldering et al. (6,820,277) [Eldering].

Regarding claim 12, Hjelsvold and Ellis disclose the method of claim 10, but fail to disclose said selection is based on a price paid by an advertiser.

In an analogous art, Eldering discloses providing advertisers the opportunity to bid upon advertisement opportunities, awarding the advertisement time slot to the highest bidder (col. 8 line 63 – col. 9 line 12).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Hjelsvold and Ellis to select an advertisement based on a price paid by an advertiser, as taught by Eldering, for the benefit of allowing advertisers to bid upon advertisement opportunities, maximizing the advertising revenues generated by the server computer system.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goldhaber et al. (5,794,210).

13. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in

such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dominic Saltarelli
Patent Examiner
Art Unit 2611

DS

HAI TRAN
PRIMARY EXAMINER